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May 18, 2006

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Mark Bourgeois

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial no.: 09/944,932
Filing date: 08/31/2001
For: Euphorbia Plant named 'Charam'
Inventor: Tickner
Atty. Docket no.: PH39
Group Art Unit: 1661
Examiner: Para
Confirmation No.: 2267

Request for Re-Instatement of Appeal Brief

This is in response to the Notice of Appeal mailed on May 8, 2006.

Applicant hereby submits the enclosed Appeal Brief to the Board of Patent Appeals and Interferences.

Since an appeal brief was previously submitted along with an appeal brief fee of \$320 and the present appeal brief fee is \$500, the Commissioner is authorized to charge the difference between the previously paid fee and the current fee of \$180 to Deposit Account number 50-2485.

Adjustment date: 05/23/2006 WAHHED1
06/12/2003 CNGUYEN 00000003 09944932
01 FC:1402 -320.00 OP

Respectfully submitted,

Mark P. Bourgeois
Reg. No. 37,782

05/23/2006 WAHHED1 00000033 502485 09944932
01 FC:1402 180.00 DA -320.00 OP

Serial No. 09/944,932



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APPEAL BRIEF

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1. Real Party in interest

The real party in interest in the present appeal brief is Nottcuts Limited.

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2. Related Appeals and Interferences

There are no related appeals or interferences.

3. Status of Claims

Claim 1 is pending. Claim 1 was finally rejected under 35 U.S.C. 102b as being unpatentable over Plant Breeders Rights grant number 03000204 in the United Kingdom published on January 1, 1996 in view of sales in the United Kingdom as early as April 1, 1998. The final rejection of claim 1 is being appealed.

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4. Status of Amendments

There are no amendments that have not been entered.

5. Summary of Claimed Subject Matter

The invention is a Euphorbia plant named 'Charam'. The invention is exemplified in claim 1, which recites a new and distinct variety of Euphorbia plant named 'Charam' as described and illustrated.

Support for this is found in the specification on pages 1-7 and is shown in figures 1-3.

6. Grounds of Rejection to be Reviewed Upon Appeal

Issue 1 - Whether claim 1 is patentable under 35 USC 102 in view of plant breeders right grant 03000204 in the United Kingdom published on January 1, 1996 and being sold in the United Kingdom as early as April 1, 1998.

7. Argument

Issue 1 - Whether claim 1 is patentable under 35 USC 102 in view of plant breeders right grant 03000204 in the United Kingdom published on January 1, 1996 and being sold in the United Kingdom as early as April 1, 1998.

Independent claim 1 recites a new and distinct variety of Euphorbia plant named 'Charam' as described and illustrated.

The Examiner has noted that the variety that is the subject of this application has previously been protected by a plant breeder's rights certificate in one or more foreign countries. The Examiner further noted that the referenced plant breeder's rights certificate was published more than one year prior to the filing date of this plant patent application in the United States. The Examiner has used 37 CFR 1.105 to request information from the Applicant regarding whether the variety was publicly available anywhere in the world prior to the filing date of the present application. The Examiner cites *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (BPAI 1992) as authority for this request for information.

In the request for information under 37 CFR 1.105 dated August 13, 2002, the Office requested the Applicant to provide copies of the plant breeders rights application, proposed denomination and grant. The Office stated that copies of these documents are not readily obtainable.

If these documents are not readily obtainable by the U.S. Patent Office that has access to a vast array of resources, then they would be difficult to obtain by an isolated plant breeder.

It is doubtful that a plant breeder would readily be able to obtain copies of plant breeders right grant 03000204 and obtain specimens of Euphorbia Charam that were only available in the United Kingdom and successfully reproduce Euphorbia Charam prior to the filing date of the present application.

The public use and availability of the subject plant variety outside of the United States is not material to a determination of "plant patentability" of a plant variety in the United States under 102b.

The examination strategy set forth by the Examiner results in a denial of plant patent protection in the United States based upon prior art which does not make the plant variety available or accessible to the American public. It is the Applicant's belief that the Federal Circuit will not support any rejection based on such an examination policy.

The Examiner cites *Ex parte Thomson*, 24 USPQ 2d 1618, 1620 (BPAI 1992) to support the contention that a printed publication describing a new asexually reproducible plant variety, combined with the availability of the variety anywhere in the world, is sufficient to bar "plant patentability" of the variety under 35 U.S.C. 102(b).

The *Ex Parte Thomson* board admits that the printed publications cited were not, in and of themselves, enabling, and attempts to make those references enabling by combining them with the public availability of the cotton seeds in Australia. A non-

enabling printed publication by itself cannot be cited as prior art under 102(b). Foreign public use alone cannot be cited as prior art under 102(b). *Ex Parte Thomson* combined these two non-prior art references.

It is improper to rely on a combination of references to anticipate the claimed invention under 35 U.S.C. 102(b). *Studiengesellschaft Kohle, M.B.H. v. Dart Industries, Inc.*, 726 F.2d 724, 726 (Fed. Cir.1984). Anticipation must be found in a single reference. It is proper to cite an additional reference in making a rejection under 35 U.S.C. 102(b) only to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in possession of the public. See *Application of Samour*, 571 F.2d 559, 565 (CCPA 1978).

Ex Parte Thomson represents an improper use of 102(b) to deny utility patent protection for a plant variety based upon prior art references which do not make the invention available to the American public.

Title 35 U.S.C. 102(b) reads, in pertinent part:

A person shall be entitled to a patent unless
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . .

If an invention has been in widespread public use in France for the last 30 years, but is not the subject of any printed publication, then the original inventor has every right to file for and obtain patent protection in the United States. Section 102(b) expressly allows such a result. The foreign use of the invention is not deemed to have made the

invention available to the American public. It is immaterial to any 102(b) analysis that the French public may have had the invention for the last 30 years.

How does the American public get access to a plant invention? In order for the American public to access, use and duplicate a plant variety, propagatable plant material from the plant in question must be available in the United States. Without access to the plant material, the plant cannot be reproduced.

Foreign asexually propagatable plant material, unlike the information in a printed publication, is not freely accessible to the American public on an unregulated basis. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States. The quarantine act imposes rigorous importation requirements.

The court in *In re LeGrice* established a perfectly workable and rational approach for applying the policy and the language of 102(b) to this unique situation. The *In re LeGrice* case was concerned with whether or not foreign plant varieties are actually available to the American public, and acknowledged that at some future point in time, a mere printed publication might enable a person to make a genetic duplicate, or clone, of a particular plant without access to the plant material itself. That day is not here yet.

The *LeGrice* court disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

Under 35 U.S.C. 102(b), an invention is not patentable if it was described in a printed publication, in this or a foreign country, more than a year prior to the filing date of the U.S. application. In order for a printed publication to serve as a reference under 35 U.S.C. 102(b), it must enable the invention. *In re Donohue*, 766 F.2d 531, 533 (Fed.

Cir. 1985. A written description of a plant variety is simply not enabling. Plant patents have always been exempt from the Section 112 written enablement requirement which applies to all utility patents. A particular plant cannot be reproduced by reference only to a printed publication alone. Congress acknowledged this concept when the Plant Patent Act of 1930 was drafted.

A non-enabling publication fails as a reference under 102(b). Foreign public or commercial activity also fails as a barring activity under 102(b). Combining these two “non-references” to make a rejection under 102(b) is not logical.

The unique and very narrow scope of protection offered by a plant patent has a direct impact on the scope of prior art that can be properly considered in determining the patentability of a new plant variety. Because a plant patent cannot be infringed without access to the new plant or its asexual progeny, a new plant variety cannot be anticipated without direct access by the American public in the United States to the new plant or its asexually reproduced progeny.

In the case of a plant patent, propagatable material of the new variety is not only essential to enable the invention. It is the invention. In the absence of propagatable material, the variety does not exist, nor can it be conjured up from the description in any printed publication, regardless of how detailed or specific. In the absence of any publicly available asexually propagatable plant material in the United States, no plant variety can, at the present level of technology, be anticipated by a mere printed publication, regardless of how detailed it is, and regardless of where it is published.

Sales in the United Kingdom of Euphorbia Charam were undertaken under the trade name of Euphorbia Redwing. The variety of the present application has been sold under the name Redwing.

It is doubtful that one skilled in the art who is interested in reproducing Euphorbia Charam would know to go to the United Kingdom and purchase plants under the different name of Redwing in order to replicate the plant.

A plant breeder reading the Plant Breeders Rights grant for Charam would at best be confused as to what plant to purchase.

A plant breeder wanting to replicate Charam would logically go out and try to purchase plants of Charam. The plant breeder would not find plants for sale under the name of Charam and therefore would not have any plants to replicate. The sale of Redwing in the United Kingdom does not enable the invention of Charam.

The office has the responsibility to establish a complete and accurate set of facts in making a rejection and may not rely upon unfound facts or unproven theories.

The knowledge or use relied on in a section 102 rejection must be knowledge or use in the United States. Prior knowledge or use which is not present in the United States, even if widespread in a foreign country, cannot be the basis of a rejection under section 102, *In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). There is no evidence to support that it was known in the United States that Charam was being sold as Redwing in the United Kingdom.

The office has not proven that a plant breeder would know to purchase plants of Redwing in order to reproduce Charam. There is no evidence to support the assertion

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that a plant breeder would know what Euphorbia plant to purchase in order to reproduce Charam.

For the foregoing reasons, the Applicant asserts that the cited Plant Breeder's Rights Certificate is not a bar to patentability of the claimed new variety under 35 U.S.C. 102(b), because of the difficulty in obtaining the publication and the uncertainty as to which variety to purchase in order to reproduce the plant.

For the extensive reasons advanced above, Appellant respectfully contends that the claim is patentable. Accordingly, reversal of all rejections is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark P. Bourgeois', with a stylized flourish at the end.

Mark P. Bourgeois
Reg. No. 37,782

8. Claims Appendix

The claims involved in the appeal follow below:

1. A new and distinct variety of Euphorbia plant named 'Charam' as described and illustrated.

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9. Evidence Appendix

There is no evidence.

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10. Related Proceedings Appendix

There are no related proceedings.